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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,762	03/19/2001	Virginia Goss Tusher	218-0016US	8102

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WONG, CABELLO, LUTSCH, RUTHERFORD & BRUCCULERI,  
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HOUSTON, TX 77070

EXAMINER

CLOW, LORI A

ART UNIT	PAPER NUMBER
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1631

MAIL DATE	DELIVERY MODE
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05/30/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/811,762

Applicant(s)

TUSHER ET AL.

Examiner

Lori A. Clow, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22, 28-30, 33, 44, 46, 58, 60, 65 and 66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 11-21, 28-30, 33, 44, 46, 58 and 60 is/are allowed.
- 6) ☒ Claim(s) 6-10, 65, and 66 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicants' response, filed 12 February 2007, has been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 1-22, 28-30, 33, 44, 46, 58, 60, 65, and 66 are currently pending. Claims 23-27, 31, 32, 34-43, 45, 47-57, 59, and 61-64 have been cancelled.

#### **Claim Objections**

Claim 22 is objected to because of the following informalities: Claim 22 contains a typographical error. The last word "into" has an extra character inserted. Appropriate correction is required.

#### **Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6 and 7 recite, "wherein said providing includes". It is unclear what "providing" step is intended to be limited. There are two steps of "providing" in claim 1: one for "providing for each of a plurality of genes" and one for "providing a list of genes". Clarification through

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clearer claim language is requested. Claims 8-10 are also rejected for being dependent on rejected claims 6 and 7.

### **Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 65 and 66 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, for the reasons set forth in the previous Office Action.

### **Response to Applicant's Arguments 35 USC 101**

1. With regard to claims 65 and 66, Applicant does not provide a specific argument in the response filed 2/12/07. Instead, Applicant provides a Table for claim 65 and 66 in which comparisons are made between flow chart questions from training guidelines and the instant claims 65 and 66.

As was stated in the previous Office Actions, the test for practical application is two-fold. No longer is practical application in the **technological arts** the standard, as is set forth by Applicant in the comparison Table presented for claims 65 and 66. Rather, practical application refers to a claimed invention that "transforms" an article or physical object to a different state or thing or a claimed invention otherwise produces a useful, concrete, and tangible result, based upon various factors stated above. The instant claims do not meet either criteria and therefore are non-statutory. Further, there is no specific result of the claimed method steps and data

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transformation, even if it is listed, does not equate to a physical transformation outside of the computer.

Note: Claims 1-22, 28-30, 33, 44, 46, 58, and 60 provide a list of genes whose associated values differ by an amount of statistical significance and thus provide for a specific output meeting the criteria set forth for statutory subject matter.

### **Conclusion**

Claims 1-5, 11-21, 28-30, 33, 44, 46, 58, and 60 are allowable, as the prior art does not teach of fairly suggest the instant method of deriving observed and expected values of an adjusted parameter for each gene in a set of genes.

### **Inquiries**

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The Central Fax Center Number is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lori A. Clow, Ph.D., whose telephone number is (571) 272-0715. The examiner can normally be reached on Monday-Friday from 10 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the

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problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

May 28, 2007

Primary Patent Examiner

Lori A. Clow, Ph.D.

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A handwritten signature in cursive script, appearing to read "Lori A. Clow", written in black ink.